

REMARKS

In view of the following remarks, reconsideration and further examination are requested.

Initially, it is respectfully submitted that the finality of the Office Action mailed March 21, 2005, should be withdrawn since a new ground of rejection was issued which was not necessitated by any amendment made to the claims.

In this regard, the patent to Yamaura et al. was newly applied to reject claim 6; however, claim 6 is a combination of former claims 1 and 2, and does not recite anything additional relative to claims 1 and 2. Yamaura et al. was not originally relied upon to reject claim 2, and claim 6 does not differ substantively from claim 2. Thus, reliance on Yamaura et al. to reject claim 6 was not necessitated by any amendment, and accordingly, it is respectfully submitted that the finality of the Office Action mailed March 21, 2005, should be withdrawn.

Claims 6-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura in view of Yamaoka or Yamaura et al. This rejection is respectfully traversed for the reasons as expressed in the response filed December 9, 2004, as well as for the following reasons.

In order for a *prima facie* case of obviousness to be established, each of the claimed features must result from a combination of the references relied upon. Each of independent claims 6 and 9 requires a shock absorber that comprises

**a second valve disc including circular apertures, and a
third valve disc having notches cooperating with the
circular apertures to form ports.**

Thus, in order for the references relied upon to properly reject claims 6 and 9, a resulting combination thereof must include a disc having circular apertures, and a disc having notches which cooperate with the circular apertures to form ports. It is respectfully submitted that none of the references relied upon by the Examiner when combined with each other would teach a combination of such two discs.

In this regard, because orifices 102b of Yamaoka do not cooperate with notches 106c to form ports, were the teachings of Miura combined with those of Yamaoka, there would be no resulting combination that would include a disc having circular apertures cooperating with notches in a disc to form ports. Rather, were Miura modified in view of Yamaoka, the resulting combination would

include a disc having orifices positioned inwardly of the notches 25a of Miura such that no ports would be formed from cooperation of these orifices and notches.

Similarly, with regard to Yamaura et al., the discs shown in Figures 3-6 each correspond to the same disc or stopper plate, but are of different embodiments. Thus, like Yamaoka, Yamaura et al. does not teach or suggest a disc having circular apertures that cooperate with notches in another disc so as to form ports. Additionally, were Miura modified in view of Yamaura et al. by substituting one of the stopper plates of Yamaura et al. for one of the discs of Miura, it is not clear, and the Examiner has provided no explanation, as to which stopper plate of Yamaura et al. would be substituted for which disc of Miura.

The rejection appears to be based on the premise that since various discs as shown in the three references can possibly be modified in terms of the sizes, locations and shapes of their openings, that one having ordinary skill in the art would have been motivated to combine any such modified discs to attain desired shock absorber characteristics, and ultimately arrive at the instantly claimed invention. This position taken is respectfully traversed for the following reasons.

It is not disputed that in column 3, lines 49-51 of Miura it is stated that “the number, the location and the configuration of the cut-outs 25a may be determined as desired”. Nor is it disputed that in column 5, lines 23-26 it is stated that “ratio between the damping force in the extension and contraction strokes of the damper particularly in the range of low piston speed can be determined as desired”. However, it is respectfully submitted that the Examiner has mis-characterized what is recited in column 1 of Miura.

In this regard, the Examiner states that column 1 expresses that the damping force may be altered by changing the configuration of the valve discs; however, this is not what is represented by column 1. Specifically, this column does not state that the damping force may be altered by changing the “configuration of the valve discs”, but rather this column states that the damping force can be chosen by changing the **thickness and the material of the valve disc** (column 1, lines 28-34). Thus, there is no teaching in Miura of changing locations, sizes and shapes of openings in valve discs so as to obtain desired damping characteristics.

In any event, even if Miura did state that certain parameters could be varied by altering locations, sizes and shapes of openings in valve discs, simply because Yamaoka and Yamaura et al.

disclose a valve disc having circular apertures would not be sufficient to demonstrate that one having ordinary skill in the art would have been motivated to combine these references to arrive at a shock absorber having a disc with circular apertures that cooperate with notches in another disc to form ports. The Examiner must provide some reasonable explanation as to why the combination of references would result in the invention as claimed, and it is respectfully submitted that the Examiner has failed to do so.

Furthermore, the Examiner has apparently restrictively considered the problem to be solved by the present invention. In this regard, that the apertures of the second valve disc and the notches of the third valve disc are arranged so that the total cross-sectional area of any of the ports is constantly greater than that of the restrictive orifices, regardless of an angular position between the second and third valve discs, is not a primary problem to be solved by the instant invention.

In this regard, as discussed in the complete paragraph on page 2 of the original specification, if a second valve disc having a C-shaped aperture as disclosed in Miura is utilized, the first valve disc may be depressed into the C-shaped aperture under pressure exerted by compression movement of the piston, and may be caused to deform permanently. Accordingly, preventing such deformation of the first valve disc is the primary problem to be solved by the instant invention. In order to solve such a problem, the present invention includes a second valve disc having circular apertures in place of the C-shaped apertures of Miura.

None of the references relied upon by the Examiner recognize or are concerned with such a problem, and accordingly, this lack of recognition coupled with no combination of the references definitely resulting in the second and third valve discs as claimed, enhances the non-obviousness of the instant invention.

In view of the above amendments and remarks, it is respectfully submitted that a *prima facie* case of obviousness has not been established, whereby the present application is in condition for allowance and an early Notice of Allowance is earnestly solicited.

If after reviewing this Amendment, the Examiner believes that any issues remain which must be resolved before the application can be passed to issue, the Examiner is invited to contact the Applicant's undersigned representative by telephone to resolve such issues.

Respectfully submitted,

Ryo SHINATA

By:



Joseph M. Gorski

Registration No. 46,500

Attorney for Applicant

JMG/edg
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
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